

JUN 06 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sterling Mortensen

Examiner: Chad Zhong

Serial No.: 09/941,467

Group Art Unit: 2152

Filed: August 29, 2001

Docket No.: 10004428-1

Title: DOCUMENT DISTRIBUTION TO MOBILE COMPUTING DEVICE**CERTIFICATE OF TRANSMISSION**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

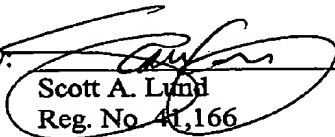
Sir:

I hereby certify that the following papers are being facsimile transmitted to the U.S.
Patent and Trademark Office, Fax No.: (571) 273-8300 on the date shown below:

1. Transmittal Letter for Appeal Brief (1 pg.); and
2. Appeal Brief under 37 C.F.R. (14 pgs.)

Respectfully submitted,

Sterling Mortensen,

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Reg. No. 41,166**16 PAGES – INCLUDING COVER PAGE**

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PATENT APPLICATION

ATTORNEY DOCKET NO. 10004428-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Sterling Mortensen

Confirmation No.: 6476

Application No.: 09/941,467

Examiner: Chad Zhong

Filing Date: August 29, 2001

Group Art Unit: 2152

Title: DOCUMENT DISTRIBUTION TO MOBILE COMPUTING DEVICE

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

1402

TRANSMITTAL OF APPEAL BRIEFTransmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on May 1, 2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
\$120

☐ 2nd Month
\$450

☐ 3rd Month
\$1020

☐ 4th Month
\$1590

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

☐ I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
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Date of facsimile: June 6, 2006

Typed Name: Scott A. Lund

Signature: 

Respectfully submitted,

Sterling Mortensen

By: 

Scott A. Lund

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Rev 1005 (ApBref)

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JUN 06 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	Sterling Mortensen	Examiner:	Chad Zhong
Serial No.:	09/941,467	Group Art Unit:	2152
Filed:	August 29, 2001	Docket No.:	10004428-1
Title:	DOCUMENT DISTRIBUTION TO MOBILE COMPUTING DEVICE		

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

This Appeal Brief is submitted in support of the Notice of Appeal filed May 1, 2006, appealing the rejection of claims 1-4, 9, 10, 12-20, 25, and 27-30 of the above-identified application as set forth in the Final Office Action mailed March 9, 2006.

The U.S. Patent and Trademark Office is hereby authorized to charge **Deposit Account No. 08-2025** in the amount of **\$500.00** for filing a Brief in Support of an Appeal as set forth under 37 C.F.R. § 41.20(b)(2). At any time during the pendency of this application, please charge any required fees or credit any overpayment to Deposit Account No. 08-2025.

Appellant respectfully requests consideration and reversal of the Examiner's rejection of pending claims 1-4, 9, 10, 12-20, 25, and 27-30.

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REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Development Company, LP having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

RELATED APPEALS AND INTERFERENCES

Appellant submits that there are no related appeals or interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-4, 9, 10, 12-20, 25, and 27-30 are pending in the application (see Claims Appendix), and are the subject of the present Appeal.

Claims 1-4, 9, 10, 12-20, 25, and 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Santamaki et al. U.S. Patent No. 6,886,036.

STATUS OF AMENDMENTS

No amendments have been entered subsequent to the Final Office Action mailed March 9, 2006. The claims listed in the Claims Appendix, therefore, reflect the claims as of March 9, 2006.

SUMMARY OF THE CLAIMED SUBJECT MATTER

One aspect of the present invention, as claimed in independent claim 1, provides a method of distributing an electronic document (12) to a mobile computing device (20) including a display (26). The method includes translating (110) a data file (16) of the electronic document into a translated data file (18) for the electronic document, including identifying a print format (54) of the electronic document; transferring (120) the translated data file for the electronic document to the mobile computing device; and displaying (130) the electronic document on the display of the mobile computing device, including converting the translated data file for the electronic document into display instructions (28) for the

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electronic document and displaying the electronic document based on the display instructions in accordance with the print format. Translating the data file includes translating (112) the data file of the electronic document into print instructions (52) for the electronic document, transferring the print instructions to a printer (60), and converting (114) the print instructions into the translated data file for the electronic document at the printer (see, e.g., Specification at p. 4, lines 3-23; p. 6, lines 14-24; p. 7, lines 1-19; p. 8, line 20 - p. 9, line 30; p. 10, line 24 - p. 11, line 24; and Figs. 1, 3, 4, 7, and 8).

One aspect of the present invention, as claimed in independent claim 17, provides a computer-readable medium having computer-executable instructions for performing a method of distributing an electronic document (12) to a mobile computing device (20) including a display (26). The method includes translating (110) a data file (16) of the electronic document into a translated data file (18) for the electronic document, including identifying a print format (54) of the electronic document; transferring (120) the translated data file for the electronic document to the mobile computing device; and displaying (130) the electronic document on the display of the mobile computing device, including converting the translated data file for the electronic document into display instructions (28) for the electronic document and displaying the electronic document based on the display instructions in accordance with the print format. Translating the data file includes translating (112) the data file of the electronic document into print instructions (52) for the electronic document, transferring the print instructions to a printer (60), and converting (114) the print instructions into the translated data file for the electronic document at the printer (see, e.g., Specification at p. 4, lines 3-23; p. 6, lines 14-24; p. 7, lines 1-19; p. 8, line 20 - p. 9, line 30; p. 10, line 24 - p. 11, line 24; and Figs. 1, 3, 4, 7, and 8).

One aspect of the present invention, as claimed in independent claim 18, provides a system for distributing an electronic document (12) to a mobile computing device (20) including a display (26). The system includes a first processor (32) adapted to translate a data file (16) of the electronic document into print instructions (52) for the electronic document and a second processor (64) adapted to convert the print instructions into a translated data file (18) for the electronic document, wherein the first processor is part of a computer (30) and the second processor is part of a printer (60). The system also includes a communication link (70) configured to link the first processor, the second processor, and the

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mobile computing device. The translated data file includes a print format (54) of the electronic document, and the second processor is adapted to transfer the translated data file to the mobile computing device via the communication link. As such, the mobile computing device is adapted to convert the translated data file into display instructions (28) for the electronic document and the display of the mobile computing device is adapted to display the electronic document based on the display instructions in accordance with the print format (see, e.g., Specification at p. 4, line 3 - p. 5, line 15; p. 6, lines 14-24; p. 7, lines 1-30; p. 8, line 20 - p. 9, line 30; and Figs. 1, 3, and 4).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Appellant seeks review of the rejection of claims 1-4, 9, 10, 12-20, 25, and 27-30 under 35 U.S.C. 102(e) as being anticipated by Santamaki et al. U.S. Patent No. 6,886,036.

ARGUMENT

Rejection Under 35 U.S.C. §102

A. Applicable Law

To anticipate a claim under 35 U.S.C. 102, a reference must teach every element of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference").

B. Rejection of claims 1-4, 9, 10, 12-20, 25, and 27-30 under 35 U.S.C. §102(e)

Because the Santamaki et al. U.S. Patent No. 6,886,036 fails to teach each and every element of the claims, the rejection of claims 1-4, 9, 10, 12-20, 25, and 27-30 under 35 U.S.C. 102(e) is not correct and should be withdrawn.

Independent claim 1 includes "translating the data file of the electronic document into print instructions for the electronic document, transferring the print instructions to a printer, and converting the print instructions into the translated data file for the electronic document at the printer."

Independent claim 17 includes "translating the data file of the electronic document into print instructions for the electronic document, transferring the print instructions to a

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printer, and converting the print instructions into the translated data file for the electronic document at the printer."

Independent claim 18 includes "a first processor adapted to translate a data file of the electronic document into print instructions for the electronic document and a second processor adapted to convert the print instructions into a translated data file for the electronic document, wherein the first processor is part of a computer and the second processor is part of a printer."

Independent claims 1, 17, and 18, therefore, each translate a data file of the electronic document into print instructions for the electronic document, transfer the print instructions to a printer, and convert the print instructions into a translated data file for the electronic document at the printer.

The Santamaki et al. patent discloses an electronic book system in which the electronic document is converted into an e-book format "at the desktop PC 10" if the emulation software is installed at the desktop PC 10 and, alternatively, an electronic book system in which the electronic document is converted into an e-book format "at the e-book server 30" if the emulation software is installed at the e-book server 30 (col. 7, lines 21-32; col. 8, lines 7-16). Thus, with the system of the Santamaki et al. patent, the electronic document is converted into an e-book format at the desktop PC 10 or at the e-book server 30. The Santamaki et al. patent, however, does not disclose the electronic document being converted at a printer. More specifically, the Santamaki et al. patent does not disclose translating a data file of the electronic document into print instructions for the electronic document, transferring the print instructions to a printer, and converting the print instructions into a translated data file for the electronic document at the printer.

For at least the reasons set forth above, Appellant submits that the Santamaki et al. patent does not teach or suggest each and every element of independent claims 1, 17, and 18. Accordingly, Appellant submits that independent claims 1, 17, and 18 are each patentably distinct from the Santamaki et al. patent. Furthermore, as dependent claims 2-4, 9-10, and 12-16 further define patentably distinct claim 1, and dependent claims 19-20, 25, and 27-30 further define patentably distinct claim 18, Appellant submits that these dependent claims are also patentably distinct from the Santamaki et al. patent. Appellant, therefore, respectfully submits that the rejection of claims 1-4, 9, 10, 12-20, 25, and 27-30 under 35 U.S.C. 102(e) is

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not correct and should be withdrawn, and that claims 1-4, 9, 10, 12-20, 25, and 27-30 should be allowed.

CONCLUSION

For the above reasons, Appellant respectfully submits that the art of record neither anticipates nor renders obvious the claimed invention. Thus, the claimed invention does patentably distinguish over the art of record. Appellant, therefore, respectfully submits that the above rejections are not correct and should be withdrawn, and respectfully requests that the Examiner be reversed and that all pending claims be allowed.

Any inquiry regarding this Appeal Brief should be directed to either Nathan Rieth at Telephone No. (208) 396-5287, Facsimile No. (208) 396-3958 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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Date: June 6, 2006
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Scott A. Lund
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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300 on this 6th day of June 2006.

By 
Name: Scott A. Lund

**Appeal Brief to the Board of Patent Appeals and Interferences
of the United States Patent and Trademark Office**

Appellant: Sterling Mortensen

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Title: **DOCUMENT DISTRIBUTION TO MOBILE COMPUTING DEVICE**

CLAIMS APPENDIX

1. (Previously Presented) A method of distributing an electronic document to a mobile computing device including a display, the method comprising:
 - translating a data file of the electronic document into a translated data file for the electronic document, including identifying a print format of the electronic document;
 - transferring the translated data file for the electronic document to the mobile computing device; and
 - displaying the electronic document on the display of the mobile computing device, including converting the translated data file for the electronic document into display instructions for the electronic document and displaying the electronic document based on the display instructions in accordance with the print format,wherein translating the data file includes translating the data file of the electronic document into print instructions for the electronic document, transferring the print instructions to a printer, and converting the print instructions into the translated data file for the electronic document at the printer.
2. (Original) The method of claim 1, wherein identifying the print format of the electronic document includes identifying at least one of a page margin, a page layout, a paper orientation, and a paper size for the electronic document.
3. (Previously Presented) The method of claim 1, wherein translating the data file includes translating the data file of the electronic document into an exchange file format.
4. (Previously Presented) The method of claim 1, wherein translating the data file includes translating the data file of the electronic document into the translated data file for the electronic document via a printer driver.
5. (Cancelled)
6. (Cancelled)

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7. (Cancelled)

8. (Cancelled)

9. (Previously Presented) The method of claim 1, wherein translating the data file of the electronic document into the print instructions includes translating the data file of the electronic document into the print instructions for the electronic document via a printer driver.

10. (Original) The method of claim 9, wherein translating the data file of the electronic document into the print instructions includes translating the data file of the electronic document into the print instructions for the electronic document at a computer including the printer driver and having the data file of the electronic document stored therein.

11. (Cancelled)

12. (Previously Presented) The method of claim 1, wherein transferring the translated data file includes transferring the translated data file for the electronic document to the mobile computing device from the printer.

13. (Previously Presented) The method of claim 12, further comprising:
linking the mobile computing device and the printer via a communication link,
wherein transferring the translated data file includes transferring the translated data file for the electronic document to the mobile computing device from the printer via the communication link.

14. (Previously Presented) The method of claim 1, further comprising:
identifying an address of the mobile computing device, wherein transferring the translated data file includes transferring the translated data file for the electronic document to the address of the mobile computing device.

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15. (Previously Presented) The method of claim 1, wherein transferring the translated data file includes transferring the translated data file for the electronic document to the mobile computing device via a computer associated with the mobile computing device.

16. (Previously Presented) The method of claim 15, wherein transferring the translated data file includes transferring the translated data file for the electronic document to the computer, and further comprising:

synchronizing the mobile computing device with the computer, including transferring the translated data file for the electronic document to the mobile computing device from the computer.

17. (Previously Presented) A computer-readable medium having computer-executable instructions for performing a method of distributing an electronic document to a mobile computing device including a display, the method comprising:

translating a data file of the electronic document into a translated data file for the electronic document, including identifying a print format of the electronic document;

transferring the translated data file for the electronic document to the mobile computing device; and

displaying the electronic document on the display of the mobile computing device, including converting the translated data file for the electronic document into display instructions for the electronic document and displaying the electronic document based on the display instructions in accordance with the print format,

wherein translating the data file includes translating the data file of the electronic document into print instructions for the electronic document, transferring the print instructions to a printer, and converting the print instructions into the translated data file for the electronic document at the printer.

18. (Previously Presented) A system for distributing an electronic document to a mobile computing device including a display, the system comprising:

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a first processor adapted to translate a data file of the electronic document into print instructions for the electronic document and a second processor adapted to convert the print instructions into a translated data file for the electronic document, wherein the first processor is part of a computer and the second processor is part of a printer; and

a communication link configured to link the first processor, the second processor, and the mobile computing device,

wherein the translated data file includes a print format of the electronic document, wherein the second processor is adapted to transfer the translated data file to the mobile computing device via the communication link, and wherein the mobile computing device is adapted to convert the translated data file into display instructions for the electronic document and the display of the mobile computing device is adapted to display the electronic document based on the display instructions in accordance with the print format.

19. (Original) The system of claim 18, wherein the print format of the electronic document includes at least one of a page margin, a page layout, a paper orientation, and a paper size of the electronic document.

20. (Original) The system of claim 18, wherein the translated data file of the electronic document includes an exchange file format.

21. (Cancelled)

22. (Cancelled)

23. (Cancelled)

24. (Cancelled)

25. (Previously Presented) The system of claim 18, wherein the first processor is adapted to translate the data file of the electronic document into the print instructions for the electronic document via a printer driver.

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26. (Cancelled)

27. (Previously Presented) The system of claim 18, wherein the first processor is adapted to transfer the print instructions for the electronic document to the second processor via the communication link and the second processor is adapted to transfer the translated data file for the electronic document to the mobile computing device via the communication link.

28. (Previously Presented) The system of claim 18, wherein the mobile computing device has an address, and wherein the second processor is adapted to transfer the translated data file to the address of the mobile computing device.

29. (Previously Presented) The system of claim 18, wherein the communication link is configured to link the second processor and an additional computer associated with the mobile computing device, and wherein the second processor is adapted to transfer the translated data file for the electronic document to the mobile computing device via the communication link and the additional computer associated with the mobile computing device.

30. (Previously Presented) The system of claim 29, wherein the second processor is adapted to transfer the translated data file for the electronic document to the additional computer, and wherein the additional computer is adapted to transfer the translated data file for the electronic document to the mobile computing device when the mobile computing device is synchronized with the additional computer.

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EVIDENCE APPENDIX

None.

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RELATED PROCEEDINGS APPENDIX

None.